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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,938	09/20/2001	Yasufumi Kozono	0033-0768P	9940
2292	7590	12/23/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			PALADINI, ALBERT WILLIAM	
PO BOX 747				
FALLS CHURCH, VA 22040-0747			ART UNIT	PAPER NUMBER

2125  
DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/955,938	KOZONO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Albert W Paladini	2125	

-- The MAILING DATE of this communication appears n th cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 September 2001.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/23/03, 8/29/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements and structural cooperative relationships of elements, such omission amounting to a gap between the necessary elements and structural connections. See MPEP § 2172.01.

### **Claim 1**

The claim recites only a single element in the “design support system,” which is “a database.” The claim then recites a group of functions associated with this database. The system has no element to receive the “data entered by said user.” A “database” is normally a storage device, so that it is not understood how it performs calculations and generates outputs. There is no element recited to provide “said user” with “a result of the calculation.”

An apparatus claim, which recites a “system”, must recite all of the elements contained in the system and the structural cooperative relationships between these elements, which achieve the desired objective recited in the preamble. This claim recites a single element, and then describes results that a user can hope to obtain. It

does not recite a group of interactive elements, which act in concert to perform one or more functions.

A definition is provided in the Microsoft Computer Dictionary as follows.

***system- 1. An assembly of component parts linked together by some form of regulated interaction into an organized whole.***

Appropriate correction and clarification is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hongu (6,829,743).

This rejection is made to the extent that the claims are understood.

In figure 8, Hongu discloses a design support system where a user 30 is connected through the Internet by means of web server 23 to the material system 10, 11. The material system can perform calculations on the design using computer 10 and store data in the materials database 11. The data is available to any user via web server 23.

#### ***Relevant Prior Art***

Knowles (6540140) discloses a method and system for manufacturing bar code scanners, where an end user provides input to a web-enabled client computer system, which can interconnect with the manufacturer's web site. A database web based server supports the generation of optical engineering models in response to scanning requirements provided by the user. The web-based server is accessible to any user.

Zizzo (6578174) discloses a chip design system where a user workstation is coupled through the Internet to a web server, which has multiple application databases within connected to an application server, which provides all of the data, needed for the design of the semiconductor chip.

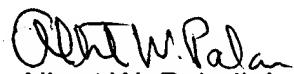
Dole (6634008) discloses a web-based system used for integrated circuit design which includes a customer work station connected through the internet to a methodology web server which in turns has access to an engineering work station to perform calculations and to various memory modules which store design data and data generated by the system.

5. Any inquiry concerning this communication or earlier communication from the examiner should be direct to Albert W. Paladini whose telephone number is (572) 272-3748. The examiner can normally be reached from 7:30 to 3:30 PM on Monday, Tuesday, Thursday, and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Leo P. Picard, can be reached on (572) 272-3749. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

December 10, 2004

  
Albert W. Paladini  
Primary Examiner  
Art Unit 2125